



IN THE UNITED STATES DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Applicant Under 37 C.F.R. § 1.47(b):
Omnicare, Inc.

Inventor: Ralph F. Kalies

Filed: 10/08/2003

Art Unit: 3626

Serial No: 10/681,954

Docket No. 036806.00431

For: METHOD FOR STORING AND REPORTING PHARMACY DATA

Mail Stop Missing Parts
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

04/01/2004 SFELEKE1 00000074 10681954
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**PETITION AND STATEMENT OF FACTS IN SUPPORT OF
FILING ON BEHALF OF INVENTOR REFUSING TO SIGN
(37 C.F.R. § 1.47(b))**

With regard to the above-identified patent application, wherein Omnicare, Inc. is the applicant under 37 C.F.R. § 1.47(b) (the "Applicant") and Ralph F. Kalies is the inventor (the "Inventor"), this petition is filed in response to the "Notice to File Missing Parts of Nonprovisional Application" mailed January 5, 2004 (copy enclosed), and is accompanied by:

- 1) a Declaration under 37 C.F.R. § 1.63 executed by the undersigned, an attorney registered to practice before the U.S. Patent and Trademark Office;
- 2) a Power of Attorney signed by an officer of Applicant, authorizing the undersigned to act on behalf of Applicant;
- 3) an assignment from the Inventor to Applicant (the "Assignment") for "METHOD FOR STORING AND REPORTING PHARMACY DATA" (the "Invention").
- 4) a Notice of Recordation Form Cover Sheet for the Assignment, for Patent Application No. 10/681,954, recorded at reel 014396, frame 0348;
- 5) a declaration by attorney James R. Eley in support of filing on behalf of inventor, evidencing the Inventor's refusal to sign papers for the above-referenced application; and
- 6) a check in the amount of \$ 370.00 representing the following fees:
\$ 130.00 missing parts surcharge;
\$ 130.00 petition fee (37 CFR §1.17(i)); and
\$ 110.00 extension of time fee (37 CFR §1.17(a)(1)).

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Void date: 04/01/2004 SFELEKE1 00000070 10681954
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I. Action Requested

Petition is hereby made in the above-identified application for the Commissioner to:

- 1) grant a one-month extension of time for reply to the Notice to File Missing Parts under 37 C.F.R. § 1.136(a);
- 2) accord the above-identified application status under 37 C.F.R. § 1.47(b) as a “Filing When an Inventor Refuses to Sign or Cannot Be Reached;” and
- 3) accept the accompanying declaration as fulfillment of the requirement under 37 C.F.R. § 1.63 to submit an oath or declaration for the above-identified application and allow the application to pass to examination.

II. Declaration Under 37 C.F.R. § 1.63

In accordance with MPEP § 409.03(b), “No Inventor Available:”

- 1) The accompanying declaration under 37 C.F.R. § 1.63 was executed by the undersigned, an attorney registered to practice before the U.S. Patent and Trademark Office and authorized to sign on behalf of the Applicant; and
- 2) an executed Power of Attorney authorizing the undersigned to act on behalf of Applicant is attached hereto as proof of authority to execute said Declaration.

III. Right of Assignee to Take Action

In accordance with 37 C.F.R. § 3.73, the Applicant offers as evidence of its right to take action on behalf of the Inventor a copy of the Assignment for the Invention, attached hereto, in which the Inventor assigned a 100% undivided interest in the Invention to Applicant. The Assignment is recorded in the Office at reel 014396, frame 0348. In the Assignment the Inventor further agreed to “execute all necessary and lawful future documents, including assignments in favor of Assignee . . . in order to perfect title in said Invention, modifications, and improvements in said Invention, applications and letters Patent” Pursuant to his employment agreement with Applicant, the Inventor is also obligated to assign all patent rights in the Invention to the Applicant.

IV. Relationship of Applicant to Inventor

The Inventor is a former employee of the Applicant.

V. Statement of the Facts, Proving that Inventor Refuses to Execute the Application Papers

Diligent efforts have been made by the Applicant to persuade the Inventor to execute the declaration for the above-identified application. However all attempts by Applicant to obtain the signature of the nonsigning Inventor have been unsuccessful. A summary of events relating to the above-identified application is provided below:

October 8, 2002 Provisional Patent Application filed, entitled “METHOD FOR STORING AND REPORTING PHARMACY DATA,” Serial No. 60/417,056.

October 14, 2002 Assignment from Inventor to Applicant (the “Assignment”) executed for “METHOD FOR STORING AND REPORTING PHARMACY DATA” (the “Invention”).

October 22, 2002 Assignment recorded at reel 013424, frame 0631 at U.S. Patent and Trademark Office for Provisional Patent Application Serial No. 60/417,056.

October 31, 2002 (on or about) Inventor’s employment agreement with Applicant expires.

October 7, 2003 Communication from attorney James R. Eley to Inventor notifying Inventor that non-provisional applications have been finalized and are ready for review by Inventor.

October 8, 2003 Nonprovisional Application for Patent filed, entitled “METHOD FOR STORING AND REPORTING PHARMACY DATA,” claiming the benefit of Provisional Patent Application Serial No. 60/417,056.

October 10, 2003 Communication from attorney Michael A. Forhan to Inventor attaching patent application specification, claims and drawings for his review.

October 13, 2003 Communication from Pixie I. Picketts, assistant to attorneys James R. Eley and Michael A. Forhan, forwarding Declaration and Power of Attorney forms to Inventor for his review and execution.

October 27, 2003 Communication from attorney James R. Eley to Applicant, noting that Inventor received patent documents and noting Inventor’s willingness to sign, pending Applicant’s approval of same.

November 7, 2003 Communication from attorney James R. Eley to Inventor, supplying Applicant’s approval for Inventor to execute patent documents.

January 5, 2004 Notice to File Missing Parts issued by U.S. Patent and Trademark Office.

March 4, 2004 Assignment recorded at reel 014396, frame 0348 at U.S. Patent and Trademark Office for Non-provisional Patent Application Serial No. 10/681,954.

March 26, 2004 Declaration from Attorney James R. Eley indicating that, in a meeting with the Inventor, the Inventor declined to sign the patent documents.

VI. Last Known Address of Inventor Refusing to Sign

The last known address of the Inventor is as follows:

Ralph F. Kalies
5772 Kumbier Road
Pickett, WI 54964

VII. Proof of Applicant's Proprietary Interest

In accordance with 37 C.F.R. § 1.47(b), the Applicant offers as evidence of its proprietary interest in the Invention a copy of the Assignment for the Invention, attached hereto, in which the Inventor assigned a 100% undivided interest in the Invention to Applicant. The Assignment is recorded in the Office at reel 014396, frame 0348. In the Assignment the Inventor further agreed to "execute all necessary and lawful future documents, including assignments in favor of Assignee . . . in order to perfect title in said Invention, modifications, and improvements in said Invention, applications and letters Patent . . ." Pursuant to his employment agreement with Applicant, the Inventor is also obligated to assign all patent rights in the Invention to the Applicant.

VIII. Necessity of Filing Application

In accordance with 37 C.F.R. § 1.47(b), the Applicant hereby states that filing of the above-identified patent application is necessary to preserve the rights of the parties identified herein with regard to the Invention. Given the above circumstances, submission of the present Petition is believed to be the only course of action which will enable the application to proceed. Further, if the application is not allowed to proceed, Applicant will suffer irreparable damage due to the loss of the claim for priority for the Invention established under 35 U.S.C. § 120 with provisional patent application number 60/417,056.

IX. Conclusion

In view of the foregoing, including the supporting evidence submitted herewith, grant of this Petition is hereby requested.

Please direct any questions regarding this Petition to Applicant's undersigned attorney at the telephone number indicated below.

Respectfully submitted:

Date: 3-30-2004

By: 

Michael A. Forhan, Reg. No. 46,706

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Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail EM103840523US, postage paid on this 30 day of MARCH 2004 in an envelope addressed to the following:

Mail Stop Missing Parts
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313


Michael A. Forhan, Reg. No. 46,706